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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,985	02/02/2002	Bettina Kuppinger	YOR920010745US1	5276
7590	12/03/2004		EXAMINER	
Samuel A. Kassatly 6819 Trinidad Drive San Jose, CA 95120			HUYNH, THU V	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,985	KUPPINGER ET AL.	
	Examiner	Art Unit	
	Thu V Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 February 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/02/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This action is responsive to communications: IDS and application filed on 02/02/2002.
2. Claims 1-20 are pending in the case. Claims 1, 14, and 20 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 14 and 20, the claims limitations are not tangibly embodied on a computer, computer readable medium or other statutory device. Data structure not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Dependent claims 15-19 are also not tangibly embodied on a computer, and are rejected under the same rationale above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-2, 7, 9, 11-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill et al., US 5,963,659, filed 05/1995, in view of Paltenghe et al., US 2001/0011250 A1, filed 11/1998.**

Regarding independent claim 1, Cahill teaches the steps of:

- processing an electronic cover to obtain a document image and to validate data elements related to the document (Cahill, col.4, lines 15-19; col.40, lines 38-46; col.29, lines 18-30 and figures 10, 16, 21; processing electronic form to obtain check image and to validate data elements related to the document, such as account number, check number, etc.);
- based on information contained in the cover, automatically collecting data and populating at least some data fields in the cover by linking the at least some data fields to an independent software application (Cahill, col.3, lines 53-61; col.40, lines 38-46; col.29, lines 18-30 and figures 10, 16, 21; collecting data in the form, such as account number, check number, etc., and linking to financial services to obtain the requested check image);

Cahill does not explicitly disclose storing at least some of the data populated in the cover for reuse by the independent software applications.

Paltenghe teaches:

- based on information contained in a cover, automatically collecting data and populating at least some data fields in the cover by linking the at least some data fields to independent software applications (Paltenghe, page 4, paragraph 46, and figures 1 and figures 12; consumer enters data on “forms, applications, etc.”. The data is stored in information bank, wherein the data used to provide to various merchants or services providers, such as billers or financial institutions);
- storing at least some of the data populated in the cover for reuse by the independent software applications (Paltenghe, page 1, paragraph 11 – page 2, paragraph 13; page 4, paragraphs 45-46; fig.1; storing the data for reuse in different services/applications of third parties, such as automatically form filling, shopping, bill payment, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Paltenghe’s reuse information from applications into Cahill’s applications to store and reuse information for other independent software application, since the combination would have provided user information for independent application process without repeatedly entering by the user.

Regarding dependent claim 2, which is dependent on claim 1, the combination of Cahill and Paltenghe teaches reusing the data populated in the cover. Cahill teaches automatically indexing the populated data in an imaging application (Calhill, col.28, lines 45-60; creating index records in index database).

Regarding dependent claim 7, which is dependent on claim 1, Cahill teaches processing the electronic cover includes setting an electronic checklist to validate critical data elements related to the document (Cahill, figures 10 and 16; the form includes electronic checklist, such as account number, check number, amount, etc.).

Regarding dependent claim 9, which is dependent on claim 7, Cahill teaches the critical data elements include a contract number (Cahill, figures 10 and 16; account number is contract number between the user and corresponding bank).

Regarding dependent claim 11, which is dependent on claim 7, Cahill teaches the critical data elements include a new transaction (Cahill, col.53, lines 37-48).

Regarding dependent claim 12, which is dependent on claim 7, Cahill teaches the critical data elements include an update (Cahill, col.42, lines 15-23).

Regarding dependent claim 13, which is dependent on claim 1, Cahill does not explicitly teach wherein the information contained in the cover includes a customer master record.

Paltenghe teaches customer record with important information is stored in Information Bank (Paltenghe, page 4, paragraph 46, and figures 1 and figures 12; consumer enters data on “forms, applications, etc.”. The data is stored in information bank, wherein the data used to provide to various merchants or services providers, such as billers or financial institutions);

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Paltenghe's storing customer record from applications or forms into Cahill's application to store customer record with important information, since the combination would have allowed such information to be reused in other independent service applications.

Claims 14-15, 17, 19 are for a computer program performing the method of claims 1-2, 7, 13 respectively and are rejected under the same rationale.

Claim 18 is for a computer program performing the method of claim 9, 11 or 12, and is rejected under the same rationale.

Claim 20 is for a data management device performing the method of claim 1 and is rejected under the same rationale.

6. **Claims 3-6, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill in view of Paltenghe as applied to claim 2, and further in view of Tammaro, US 2001/0011246 A1, filed 08/1998.**

Regarding dependent claim 3, which is dependent on claim 2, Cahill teaches the independent software application using the cover to review a submission (Cahill, col.43, lines 23; col.29, lines 18-30).

Tammaro teaches independent software applications using cover to review submission (Tammaro, abstract, page 2, paragraphs 14-21 and 25; collecting data in a form and linking to independent service applications, such as financial institutes or loan service provider for review a submission).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Tammaro's teaching into Cahill and Paltenghe to provide a form with a series of screen and the form is used to review from different independent services applications. The combination would have allowed the form to be used in Cahill's financial services and Tammaro's financial or other service providers.

Regarding dependent claim 4, which is dependent on claim 2, Cahill teaches the independent software application using the cover to update a request status (Cahill, col. 34, line 61 – col.35, line 24; updating a request status).

Tammaro teaches independent software applications using cover for reviewing and response to the submission (Tammaro, abstract, page 2, paragraphs 14-21 and 25; collecting data in a form and linking to independent service applications, such as financial institutes or loan service provider for review a submission. After review, response is transmitted to the server. The server transmits the response for display at user computer).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Cahill's updating request status into Tammaro independent service applications to provide and update status of the request, since request status,

such as request, pending, received, or exported is used to indicate as well as keep track current position of the request in process.

Regarding dependent claim 5, which is dependent on claim 2, Cahill teaches the independent software application using the cover to initiate a workflow for subsequent processing (Cahill, col.32, lines 27-37).

Tammaro teaches independent software applications using cover to initiate a workflow for subsequent process (Tammaro, abstract, page 2, paragraphs 14-21, 25; page 3, paragraph 32; collecting data in a form and linking to independent service applications, such as financial institutes or loan service providers for review. After review, response is transmitted to the server. The server transmits the response for display at user computer).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Tammaro's teaching into Cahill and Paltenghe to provide a form with a series of screen and the form is used to review from different independent services applications. The combination would have allowed the form to be used in Cahill's financial services and Tammaro's financial or other service providers.

Regarding dependent claim 6, which is dependent on claim 3, Cahill teaches feeding collected data to one or more independent software applications (Cahill, col.29, lines 18-30; providing collected data to financial services to obtain the customer's image request).

Claim 16 is for a computer program performing the method of claim 3, 4 or 5, and is rejected under the same rationale.

7. **Claims 8, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill in view of Paltenghe as applied to claim 7, and further in view of Katsumata et al., US 6,301,591 B2, filed 03/1998.**

Regarding dependent claim 8, which is dependent on claim 7, Cahill does not explicitly teach the critical data elements include a customer number.

Katsumata teaches critical data elements include a customer number (Katsumata, fig.4, “customer number”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Katsumata’s customer number into Cahill’s form for requesting check image, since customer number is one of significant identifiers which is used to finding requested data.

Claim 18 is for a computer program performing the method of claim 8 and is rejected under the same rationale.

8. **Claims 10, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill in view of Paltenghe as applied to claim 7, and further in view of Guthrie et al., US 2002/0052841 A1, priority filed 10/2000.**

Regarding dependent claim 10, which is dependent on claim 7, Cahill does not explicitly disclose the critical data elements include a mode of transmittal.

Guthrie teaches online payment system, wherein users maintain checking, saving, money market accounts can be used in person-to person, person-to-business and business-to-business payments (Guthrie, abstract, page 3, paragraph 31).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included a mode of transmittal into Cahill's from, since the mode of transmittal, such as checking, saving, money market is one of information which is used to finding requested data.

Claim 18 is for a computer program performing the method of claim 10 and is rejected under the same rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pennell et al., US 2002/0013788 A1, filed 1998, teaches method for automatically learning information used for electronic form filling.

Brown et al., US 2003/0050919 A2, filed 09/2001, teaches method for providing access rights information in portion of a file.

Iwasaki, et al., US 6,19,998 B2, filed 07/1998, teaches method for generating multiple degreeed database for images.

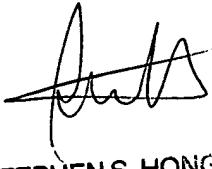
Art Unit: 2178

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 273-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 273-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
November 19, 2004



STEPHEN S. HONG
PRIMARY EXAMINER